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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/362,394	07/28/1999	CHONG-JIN OON	56972/JPW/AK	6815

7590

07/23/2003

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EXAMINER

WORTMAN, DONNA C

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 07/23/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/362,394

Applicant(s)

OON ET AL.

Examiner

Donna C. Wortman, Ph.D.

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--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 69-85, 87-105.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

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Primary Examiner  
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Continuation of 3. Applicant's reply has overcome the following rejection(s): Rejection of claims 85, 87-92, 94 and 95 under 35 USC 112, first paragraph.

Applicant's amendment of claim 85 and cancellation of claim 86 has overcome the rejection of claims under 35 USC 112, first paragraph, as set out in the last Office action, Paper No. 22.

With respect to the rejection of pending claims 69-85 and 87-105 under 35 USC 103(a) over Stuyver et al. in view of Guo et al. and US Patent 6,100,030 to McCasky Feazel et al. as previously set out in Paper No. 22 at pages 3-5, Applicant has reviewed the standards for obviousness and again has asserted that the references fail to teach the oligonucleotide sequences SEQ ID NO's 1, 3, 4, 5, 6, and 7, or specific fluorescent labels, and C-7 amine. Applicant agrees that Guo et al. and McCasky Feazel et al. teach "certain techniques."

These arguments have been considered but not found persuasive. Applicant has asserted in general that Applicant's sequences are not taught, but has presented neither argument nor factual evidence as to why each of the instant primers and probes would not have been obvious over the primers and probes of Stuyver et al. that were particularly cited as relevant to the claimed HBsAg primers and probes; see Paper No. 22, page 4, lines 2-4, citing Stuyver's primers SEQ ID NO's 75, 76, 94, 104, and 105, and especially citing Stuyver's probes SEQ ID NO's 77-82, which are directed to the codon 145 region, both mutant and wild-type, and which are only slightly different from Applicant's probes, differing in length from Applicant's by having only one more nucleotide at each end. It is also noted that Applicant's primers and probes are recited as "comprising" or "having" the recited nucleotide sequences, allowing for longer


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primers and probes, and that Stuyver was cited as teaching a range of sizes of 10-25 nucleotides for primers and probes (see Paper No. 22, page 3, line 14)..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna C. Wortman, Ph.D. whose telephone number is 703-308-1032. The examiner can normally be reached on Monday-Thursday, 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Donna C. Wortman, Ph.D.  
Primary Examiner  
Art Unit 1648

dcw  
July 21, 2003